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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,376	04/20/2004	Nozomu Tamoto	252035US DIV	3769

22850 7590 11/13/2006

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EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,376

Applicant(s)

TAMOTO ET AL.

Examiner

Vickey Ronesi

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-26,28-32 and 47-60 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,7-25,28-32 and 47-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26 and 51-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/21/06, 9/27/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections, except for those given below, are withdrawn in light of applicant's amendment filed 9/7/2006.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Information Disclosure Statement

4. The Information Disclosure Statements (IDS) dated 3/21/2006 and 9/27/2006 have been considered, however, U.S. Application No. 11/480,517 has been struck from the IDS because it is not a published document and U.S. Application No. 10/827,376 has been struck from the IDS because it is the instant application.

Claim Rejections - 35 USC § 102/103

5. Claims 26, 51-56, 58, and 60 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakao et al (US 4,559,288).

The rejection is adequately set forth in paragraph 4 of Office action mailed 3/6/2006 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

6. Claims 26, 51, 52, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patzschke et al (US 6,329,020).

The rejection is adequately set forth in paragraph 5 of Office action mailed 3/6/2006 and is incorporated here by reference.

7. Claims 26 and 51-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanamori et al (US 6,335,061) in view of Patzschke et al (US 6,329,020).

The rejection is adequately set forth in paragraph 6 of Office action mailed 3/6/2006 and is incorporated here by reference.

Response to Arguments

8. Applicant's arguments filed 9/7/2006 have been fully considered but they are not persuasive. Specifically, applicant argues that the data in the application as originally filed and in the 37 CFR 1.132 Declaration filed 12/23/2005 establish criticality for the process of mixing the ingredients in an alumina ball mill in the product-by-process claim.

In response to the argument, the data is considered to be insufficient to establish a criticality for mixing with an alumina ball mill since the data is not commensurate in scope with the present claims or comparable to the prior art. While the alumina ball mill improves the dispersion of the exemplified composition containing alumina as filler and a polycarboxylic acid polymer with an acid value of 180 as the organic compound, there is no suggestion that all compositions encompassed by the composition limitations would also exhibit such improved

Art Unit: 1714

properties when mixed with a ball mill containing only alumina balls. In particular, the prior art discloses coating compositions comprising fillers other than alumina and other organic compounds having different acid values which would not necessarily be affected by a process of mixing in a ball mill containing only alumina balls. Furthermore, page 71, lines 5-10 of applicant's specification establishes a relationship between alumina as filler and alumina balls which suggests that a composition containing a filler other than alumina would not be affected by mixing in a ball mill containing only alumina balls. Case law holds that "[i]f the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Conclusion

9. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1714

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/9/2006
Vickey Ronesi



Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700